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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/753,071	01/08/2004	Tadashi Narita	038788.53145US	5429

23911 7590 09/28/2006

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EXAMINER

HU, HENRY S

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

5

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/753,071	Applicant(s) NARITA ET AL.	
	Examiner Henry S. Hu	Art Unit 1713	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 18 September 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

H. H.
Sept 25, 2006

D. W.
 DAVID W. WU
 SUPERVISORY PATENT EXAMINER
 BIOLOGY CENTER 1700

Continuation of 11. NOTE: The reconsideration after final has been thoroughly studied by this examiner. However, it does not place the application for allowance after final action because:

Current two parent Claim 4 and Claim 11 as well as their dependent claims are not further amended, they are thereby still fundamentally covered by those arguments as discussed in the final office action. Applicants first argue the restriction requirement, and then argue the motivation to link Mowrer with any of the two primary references including Ohmori and Suzuki. In a very close examination, the examiner has noticed at least three key points in view of pages 12-15 of Remarks, particularly on the replacement of F on -O-R1-CF2-CF(CF3)OR2 with H so as to become the claimed -O-R1-CF2-CH(CF3)OR2.

First, Applicants have presented several reasons why -CH-, -C(CH3)-, -CF-, and -C(CF3)- are NOT equivalent and interchangeable (see page 13 of Remarks). Additionally, Applicants have pointed out that the polycondensation will not proceed with structures of Ohmori and Suzuki due to steric hindrance by R2 groups.

Secondly, Applicants may have presented on page 14 of Remarks some very useful evidence and may be with unexpected result for possible overcome of 103 rejections. However, it will take more time to check for full consideration at this critical situation. Therefore, the 103(a) rejections of parent Claims 4 and 11 are sustained so far.

Thirdly, Examiner will need time so as to reconsider the use of USPG-PUB 2003/0232940 A1 to Komoriya, which has explicitly shown that pendent groups with -C(CF3)2-(OH) and -C(CF3)2-(OR) (wherein R is alkyl, perfluoroalkyl or acid-labile protection group) in monomers may not change the polymerizability of monomers as well as its polymers' application.

In summary, a new consideration and maybe new search is thereby required to be sure of all the above questions being thoroughly answered.

Hidj
Sept. 25, 2006